

REMARKS

Claims 1-4 are pending in this application. By this Amendment, claims 5-20 are canceled without prejudice to, or disclaimer of, the subject matter recited therein.

Reconsideration of the rejections in view of the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments canceled withdrawn claims); and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Merkling in the November 7, 2007 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

The Office Action, on page 2, rejects claim 1 under 35 U.S.C. §102(b) over U.S. Patent Application Pub. No. 2002/0178707 to Vance et al. (hereinafter "Vance"). The Office Action, on page 3, rejects claims 1 and 2 under 35 U.S.C. §102(b) over WO 00/01463 to Hoj et al. (hereinafter "Hoj"). The Office Action, on page 5, rejects claim 3 under 35 U.S.C. §103(a) over Hoj in view of U.S. Patent No. 5,384,110 to Muramatsu et al. (hereinafter "Muramatsu"). The Office Action, on page 6, rejects claim 4 under 35 U.S.C. §103(a) over Hoj and Muramatsu, and further in view of EP 1018357 A1 to Loncke. These rejections are respectfully traversed.

Independent claim 1 recites, among other features, wherein a surface of the at least one fine coating layer does not carry the oxidation catalyst thereon. Neither Vance, nor Hoj can reasonably be considered to teach, or to have suggested, this feature.

Regarding the §102(b) rejection of independent claim 1 over Vance, the Office Action, on page 3, asserts that paragraph [0039] of Vance allegedly discloses a discriminating layer 12 that allegedly corresponds to the claimed at least one fine coating layer. Further, the Office Action, in the Response to Arguments, asserts that paragraph [0039] allegedly discloses that a surface of the discriminating layer 12 does not carry a catalytic material thereon. However, as agreed by Examiner Merkling during the personal interview, these assertions are incorrect.

In order to find features anticipated, the reference "must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." Nowhere in paragraph [0039] does Vance explicitly disclose a surface of the discriminating layer 12 does not carry a catalytic material. In fact, paragraph [0040] indicates that it may. Since Vance does not explicitly disclose this feature, in making the rejection, the Office Action must be relying on a theory of inherency. The standard for inherency is that the allegedly inherent characteristic must necessarily flow from the teachings of the reference. In particular, based on the disclosure in paragraph [0040] of Vance, the exclusion of a catalytic material on a surface of the discriminating layer 12 does not necessarily flow and is therefore not an inherent feature. Again, paragraph [0040] of Vance discloses that the discriminating layer 12 may have a catalyst formed on its surface. Accordingly, for at least this reason and as agreed by Examiner Merkling during the personal interview, Vance neither explicitly, nor inherently discloses that the discriminating layer 12 excludes a catalytic material formed thereon. As such, Vance cannot reasonably be considered to teach, or to have suggested, all of the features positively recited in claim 1.

Regarding the §102(b) rejection of independent claim 1 over Hoj, The Office Action, on page 4, asserts that the membrane of claim 48 of Hoj corresponds to the claimed at least one fine coating layer with all of the features recited in claim 1 of this application. The Office Action, on page 4, further asserts that the method of making the filter of Hoj, recited in claim 43, suggests that a catalyst is applied to the filter body before the membrane is coated on the filter, and therefore no catalyst is applied to the surface of the membrane. However, these assertions are incorrect.

Claim 36 of Hoj recites steps a), b) and c) for forming the filter device. Further, claim 44, which depends from claim 43, recites that the membrane is formed either after step a), or e). In this regard, the membrane of Hoj may be formed after step a) and before step b), that is, before applying a catalytically active material. Accordingly, the membrane may be coated by a catalytically active material. Further, the disclosure of Hoj does not indicate that the membrane is not applied before applying a catalytically active material. Thus, for at least these reasons, Hoj neither explicitly, nor inherently discloses wherein a surface of the at least one fine coating layer does not carry the oxidation catalyst thereon. As such, Hoj cannot reasonably be considered to teach, or to have suggested, all of the features positively recited in claim 1. Further, claim 2 is also not taught, nor would it have been suggested, for at least the dependence of claim 2 directly on an allowable independent claim 1, as well as for the additional features recited therein.

Additionally, claim 3 is also neither taught, nor would it have been suggested, by Hoj, even in combination with Muramatsu, which is not applied in a manner that would overcome of the above-identified shortfalls in the application of Hoj to the subject matter of at least independent claim 1.

Furthermore, claim 4 is also neither taught, nor would it have been suggested, by Hoj, even in combination with Muramatsu and Loncke, which are not applied in a manner that

would overcome of the above-identified shortfalls in the application of Hoj to the subject matter of at least independent claim 1.

Accordingly, reconsideration and withdrawal of the §102(b) and §103(a) rejections are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-4 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: November 23, 2007

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